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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/751,358   | 01/05/2004  | Richard Herbst       | P-1885              | 2244             |
| 7590   | 06/29/2004  |                      | EXAMINER            |                  |
| Charles J. Prescott, P.A.<br>Suite 115<br>2033 Wood Street<br>Sarasota, FL 34237 |             |                      | GRILES, BETHANY L   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3643                |                  |

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                         |  |
|------------------------------|--------------------------------------|-------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>               | <b>Applicant(s)</b>     |  |
|                              | 10/751,358                           | HERBST ET AL.           |  |
|                              | <b>Examiner</b><br>Bethany L. Griles | <b>Art Unit</b><br>3643 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 January 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Febvre et al. US2547273 in view of Bovino US4720932.

4. Regarding claims 1-3 and 7, Le Febvre et al. disclose an elongated handle 6 having a proximal end of said handle and a grasping or gripping portion 7 arcuately extending away from a longitudinal axis of said straight portion and terminating at a distal end of said handle; a fish engaging member having a substantially straight shank portion 16 and an arcuately shaped hook portion 15' terminating in a sharpened distal tip 15 thereof; said shank portion 16 connected in substantially collinear alignment within, and extending from said proximal end (see detail in Fig 5), said shank portion 16 being positionable in a plurality of different aligned positions.

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5. Le Febvre et al. do not disclose that the hook portion is rotatable about the longitudinal axis with respect to the grasping portion.
6. Bovino discloses a hook portion which is rotatable about the longitudinal axis with respect to the grasping portion (col 4, lines 10-14).
7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Bovino of an axially rotatable hook portion to the invention of Le Febvre et al. in order to create a fishing gaff which could withstand the powerful and wrenching force of a struggling fish without breaking the grip of the person retrieving the fish. Since Le Febvre et al. do teach a rotational motion of the shank portion 16 of the disclosed gaff, it would have been obvious to further extend that feature to include a second direction of rotation as disclosed by Bovino.
8. Regarding claim 4, Le Febvre et al. disclose the handle portion not only is hollow, but also has a substantial groove running along its length (see Figs 1 and 2). Examiner asserts that these features would enable the structure to be buoyant in water.
9. Regarding claim 5, Le Febvre et al. disclose a resilient protective cover (recess 14 of the handle) releasably attachable to the distal end of the hook 15.
10. Regarding claim 6, Le Febvre et al. disclose the handle has a uniform oval cross section (refer to Fig 4).

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson US6293601; Cunningham US5171052; Robertson

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US4739573; Snell et al. US4734984; Dooley US4691465; Pendlebury US4148512;

Shackel Us2584371; Martin US2679429; Winn US3310853; Leonard US3863377;

Tudisco US3955302.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bethany L. Griles whose telephone number is 703.305.1839. The examiner can normally be reached on Monday through Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 703.308.2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bethany L. Griles  
Examiner  
Art Unit 3643

WLF  
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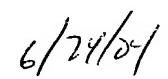
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6/24/04